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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/676,098	10/02/2003	Akira Higuchi	XA-9941	8393
181	7590	11/02/2006	EXAMINER	
MILES & STOCKBRIDGE PC 1751 PINNACLE DRIVE SUITE 500 MCLEAN, VA 22102-3833			CARPIO, IVAN HERNAN	
			ART UNIT	PAPER NUMBER
			2841	

DATE MAILED: 11/02/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/676,098

Applicant(s)

HIGUCHI ET AL.

Examiner

Ivan H. Carpio

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 02 August 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 7-10, 13 and 29-55 is/are pending in the application.
- 4a) Of the above claim(s) 13, 29, 31-39, 44, 45 and 47-55 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 7-10, 30, 40-43 and 46 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Response to Arguments***

The applicant's only relevant argument in regards to the elected claims is that neither Sun nor Niwata teach a resistance connected between a first one of the plurality of adapter external terminals and at least one of the adapter internal terminals, with a supply voltage or ground voltage being applied to the resistance to cause a value to be present at one of the plurality of external terminals of the IC card of the first standard, wherein the value is between said supply voltage and ground, examiner respectfully disagrees. Since there is no such thing as a perfect conductor, every conductor has a certain resistance. In our case Sun teaches a wiring line (see examiner's figure) which acts as a resistance between the adapter external and internal terminals, furthermore since the adapter and IC card are useless without a power source it is inherent that a source voltage is applied to the adapter external terminal and that due to the resistance in the wiring line voltage drops to some value between the source and ground at the IC card external terminals.

### ***Claim Objections***

Claim 8 recites the limitation "said resistor". There is insufficient antecedent basis for this limitation in the claim, particularly because there is a difference between "a resistance" as stated in claim 7 and a "resistor" as stated in claim 8. Examiner is going to read "resistor" as "resistance" in the rejection.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 7,9,10,40,42 and 43 are rejected under 35 U.S.C. 102(e) as being anticipated by Sun (US Patent 6663007).

With respect to claim 7, Sun discloses an adapter having an interior space which fits a profile of an IC card of a first standard, the adapter having a profile of an IC card of a second standard, said adapter comprising: (a) a plurality of adapter external terminals (see examiner's figure); (b) a plurality of adapter internal terminals (see examiner's figure) which are disposed at positions to be in contact with a plurality of external terminals of the IC card of the first standard when said IC card is placed into said adapter interior space; (c) wiring lines (see examiner's figure) which connect said adapter external terminals and said adapter internal terminals; and (d) a resistance connected between a first one of the plurality of adapter external terminals and at least one of the adapter internal terminals, with a supply voltage or ground voltage being applied to the resistance to cause a value to be present at one of the plurality of

external terminals of the IC card of the first standard, wherein the value is between said supply voltage and ground (see Response to Argument section above).

With respect to claim 9, Sun discloses an adapter internal terminals have a generally rectangular profile in plan and are laid out to have their 10ng side extending along the card insertion direction, of the first standard (see examiners figure).

With respect to claim 10, Sun teaches that the adapter internal terminals have a configuration which bulges as viewed in a cross section taken along the card insertion direction of the first standard (Fig. 5).

With respect to claim 40, Sun teaches an adapter comprising: a plurality of adapter external terminals; an interior region constructed to accept an IC card conforming to a first standard (see examiner's figure); a plurality of adapter internal terminals which are disposed at positions to be in contact with a plurality of external terminals of the IC card conforming to the first standard when said IC card is placed into said interior region (see examiner's figure); conductive traces which connect said adapter external terminals and said adapter internal terminals (see examiner's figure); and a resistance connected between a first one of the plurality of adapter external terminals and at least one of the adapter internal terminals, with a supply voltage or ground voltage being applied to the resistance to cause a value to be present at one of the plurality of external terminals of the IC card of the first standard, wherein the value is between said supply voltage and ground; wherein the adapter has outer dimensions of an IC card of a second standard (see Response to Argument section above).

With respect to claim 42 and with all the limitations of claim 40, Sun teaches that the adapter internal terminals have a generally rectangular profile in plan and are laid out to have their long side extending along the card insertion direction of the first standard (see examiners figure).

With respect to claim 43 and with all the limitations of claim 40, Sun teaches that the adapter internal terminals have a configuration which bulges as viewed in a cross section taken along the card insertion direction of the first standard (note the bulging of the internal terminals in the examiners figure and Figure 5).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 8 and 41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sun in view of Niwata.

With respect to claims 8 and 41 Sun teaches all of the limitations except a mechanical switch connected between the first adapter external terminal with said resistance connected thereto and another of the plurality of adapter external terminals. Niwata teaches a mechanical switch connected between the first adapter external terminal with said resistance connected thereto and another of the plurality of adapter external terminals. It would have been obvious to one of ordinary skill in the art at the

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time of the invention to have mechanical switch connected between the first adapter external terminal with said resistance connected thereto and another of the plurality of adapter external terminals, as taught by Niwata, to the device taught by Sun for the purpose of allowing different configurations for the adapter.

Claims 30 and 46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sun.

Sun teaches all of the limitations of claims 30 and 46 except that the second standard is the SD (secure digital) card standard. SD card standards are well known in the art in fact Sun discloses and ~~X~~ SD card (Fig. 1c). It would have been obvious to one of *SR 10/30/06* ordinary skill in the art at the time of the invention to modify the second standard, taught by Sun, to be of SD standard for the purpose of using other card standards with the SD standard interface thus allowing for greater compatibility.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

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shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ivan H. Carpio whose telephone number is 571-272-8396. The examiner can normally be reached on M-R 6:00am - 4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dean Reichard can be reached on 571-272-1984. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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